

## REMARKS

### I. Status Summary

Claims 1 and 3 are pending in the present application. Claim 3 currently stands withdrawn as being directed to non-elected subject matter. Claim 1 has been examined by the U.S. Patent and Trademark Office (hereinafter "the Patent Office") and currently stands rejected.

Claim 1 has been amended. Withdrawn claim 3 has been amended. Support for the amendments can be found in the instant application as filed. No new matter has been added.

Reconsideration of the application in view of the amendments and the remarks set forth herein below is respectfully requested.

### II. Response to Rejections under 35 U.S.C. § 112, First Paragraph

Claim 1 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to meet the enablement requirement. The Patent Office contends that the previous rejection regarding the scope of enablement was not overcome by amending the claims to delete the terms "monocyclic or polycyclic alicyclic hydrocarbon groups, monocyclic or polycyclic hydrocarbon groups or heterocyclic groups." The Patent Office contends that the specification does not provide support for how to make optically active hydroxylated compounds using compounds of chemical formulas 1 and 2 where  $R^6/R^7$  is "aryl" and  $X^1/X^2$  is  $SR^{10}$  and  $NR^{11}$ . The Patent Office further contends that, while the specification is enabling for  $R^6$  being unsubstituted phenyl,  $R^7$  being phenyl or benzyl, and  $R^1/R^2$  being t-butyl; it does not reasonably provide enablement for  $R^1/R^2$  and  $R^6/R^7$  being "aryl."

After careful consideration of the rejection and of the Patent Office's comments, applicants respectfully traverse the rejection and offer the following remarks.

Initially, without acquiescing to the rejection and in an effort to expedite allowance of the subject application, applicants respectfully submit that claim 1 has been amended herein to recite that  $R^6$  and  $R^7$  can be phenyl groups, benzyl groups, phenyl ethyl groups, or phenyl vinyl groups. In addition, claim 1 has been amended to recite that each  $R^1$  and  $R^2$  group is an alkyl group. Support for the amendment can be

found in claim 1 as originally filed. Additional support regarding “phenyl,” “benzyl,” “phenyl ethyl,” and “phenyl vinyl” can be found in the instant specification at page 5, lines 3-4 and in Table 1 on page 9, particularly, in Examples 1, 3, 8, 9, 13 and 14 of Table 1.

Applicants respectfully submit that with respect to 35 U.S.C. § 112, first paragraph, the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” See Manual of Patent Examining Procedure (hereinafter “MPEP”) § 2164.08, citing *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Further, the manner in which “a teaching is set forth, by specific example or broad terminology is not important.” See MPEP § 2164.08, citing *In re Marzocchi*, 439, F.2d 220, 223-24 169 USPQ 367, 370 (CCPA 1971). In particular, not everything necessary to practice the invention need be disclosed. See MPEP § 2164.08, citing *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Finally, the scope of enablement must only bear a “reasonable correlation to the scope of the claims.” See MPEP § 2164.08, citing *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Applicants respectfully submit that in view of the amendment, the Patent Office’s remarks regarding “aryl” have been rendered moot. Applicants further respectfully submit that the working examples (see e.g., Table 1 of the instant specification at page 9) provide support that has reasonable correlation to the scope of the currently recited  $X^1/X^2$ ,  $R^1/R^2$  and  $R^5$ - $R^8$  groups.

Accordingly, applicants respectfully submit that claim 1 meets the enablement requirement of 35 U.S.C. § 112, first paragraph. Applicants respectfully request that the rejections of claim 1 under 35 U.S.C. § 112, first paragraph, be withdrawn and further ask that claim 1 be allowed at this time.

### III. Response to Obviousness-Type Double Patenting Rejections over the ‘307 Patent

Claim 1 has been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 2, 4, and 6-8 of U.S. Patent No. 7,541,307 (hereinafter “the ‘307 Patent”).

In the interest of facilitating prosecution and without acquiescing to the contentions of the Patent Office, applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c).

In view of the Terminal Disclaimer, applicants respectfully request withdrawal of the non-statutory obviousness-type double patenting rejection of claim 1. Applicants further submit that this claim is in condition for allowance and respectfully solicit a Notice of Allowance to that effect.

In submitting the attached Terminal Disclaimer, applicants do not acknowledge that the subject matter recited in the conflicting claims is not patentably distinct. Moreover, applicants do not acknowledge that the subject matter recited in the rejected claims of the present patent application is an obvious variation of the subject matter recited in one or more claims in the cited U.S. patent. Indeed, the Federal Circuit has noted that a Terminal Disclaimer "is not an admission of obviousness of the later filed claimed invention in light of the earlier filed disclosure for that is not the basis of the Disclaimer." Quad Environmental Technologies v. Union Sanitary District, 20 U.S.P.Q.2d 1392, 1394 (Fed. Cir. 1991).

The Federal Circuit further noted:

In legal principle, the filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient "obviation" into an admission or acquiescence or estoppel on the merit.

Quad Environmental Technologies, 20 U.S.P.Q.2d at 1394-95.

Therefore, with the submission of the Terminal Disclaimer provided herewith, applicants are simply availing themselves of the statutory function of removing the double patenting rejection.

Accordingly, applicants respectfully submit that the instant rejection has been addressed, and respectfully request that it be withdrawn at this time.

IV. Withdrawn Claim

Withdrawn claim 3 has been amended to recite that R<sup>1</sup> and R<sup>2</sup> are alkyl and that X<sup>1</sup> and X<sup>2</sup> are -OH or -OMe. Support for the amendment can be found in claim 3 as originally filed. Accordingly, applicants respectfully note that the catalyst of claim 3 is commensurate in scope with the catalyst recited in pending claim 1.

CONCLUSIONS

Should there be any minor issues outstanding in this matter the Examiner is respectfully requested to telephone the undersigned attorney. Early passage of the subject application to issue is earnestly solicited.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any other fees associated with the filing of this correspondence to Deposit Account Number 50-0426.

Respectfully submitted,

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